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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,380

10/16/2003

Matthew F. Brown

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2123

28523

7590

04/27/2005

PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,380

Applicant(s)

BROWN ET AL.

Examiner

Chukwuma O. Nwaonicha

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of February 18, 2005.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-14 are pending.
4. The rejection under 35 USC § 112, second paragraph set forth in claims 1 and 4 of the previous Office Action of November 18, 2004 is withdrawn in response to applicants' amendments.
5. The obviousness-type double patenting rejection set forth in claims 1-4 and 8-11 of the previous Office Action of November 18, 2004 is withdrawn in response to applicants' terminal disclaimer.

Claim Rejections - 35 USC § 102

The rejection under 35 U.S.C 102, as being anticipated by Kath et al., {WO 99/40061} and Brown et al., {WO 98/38167} set forth in claims 1-14 of the previous Office Action of November 18, 2004 is maintained.

Applicants argue that the present invention is novel over Brown et al. that at least because the compounds disclosed by Brown et al. are within the scope of the first proviso of present claim 1, that if R⁷ is a bond both R⁷ and R⁸ may not be hydrogen unless R¹ is (C₂-C₉)heteroary substituted with one or more groups of oxygen. Applicants further argue that the compounds of Brown et al. have a hydroxyl group corresponding in position to the -O-L-R⁷ group of the presently claimed compounds of general formula 1.

Applicants' argument filed February 18, 2005 have been fully considered but they are not persuasive because the applicants claimed compound of general formula 1 still reads on the species of Brown et al. when L is a bond and R⁷ is hydrogen. The Examiner notes that the proviso read may which is conditional, meaning that R⁷ may or it may not be hydrogen. See claim 1 of the present invention, page 7.

The rejection under 35 U.S.C 102, as being anticipated by Brown et al. is maintained for the reason given above.

New Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

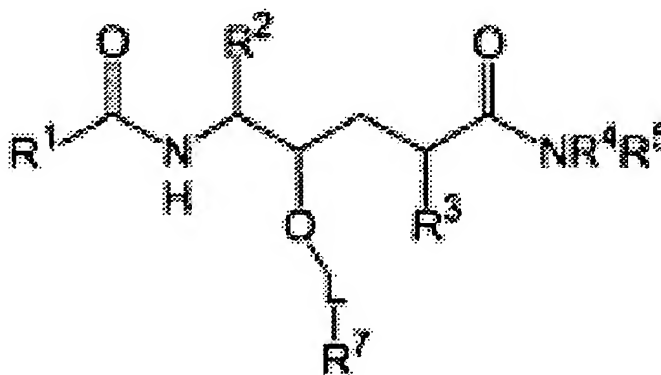
USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al., {WO 98/38167}.

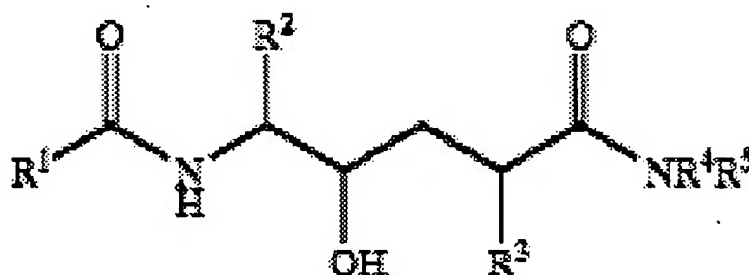
Applicants claim quinoxaline derivatives of general formula 1 and their compositions; wherein all the variables are as defined in the claims;



formula I

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

Brown et al. teach a compound of the general formula II:



formula II

wherein all the variable are as defined in the claims. See columns 63-69.

Ascertainment of the difference between the prior art and the claims (M.P.E.P..**§2141.02)**

Applicants' compounds of general formula I differ from Brown et al. in that Brown et al. teach a compound with a hydroxyl group while applicant claim compounds of general formula II wherein R⁷ is hydrogen. Another difference between applicants claimed invention and Brown et al. is that the genus (compounds of general formula II with the substituents; R¹, R², R³, R⁴, R⁵ and R⁶) of Brown et al. is more limited than the presently claimed invention (compounds of general formula I with the substituents; R¹, R², R³, R⁴, R⁵, R⁶ and R⁷). That is, the presently claimed invention encompasses the species of Brown et al. They differ in that the Brown et al. compounds are a subgenus of the claimed compounds.

Finding of prima facie obviousness—rational and motivation (M.P.E.P.. §2142-2143)

The instant claimed quinoxaline derivatives and their compositions would have been suggested to one of ordinary skill because one of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention since Brown et al. specifically teach quinoxaline derivatives. Said person would have been motivated to practice the teaching of Brown et al. by varying the substituents (R¹, R², R³, R⁴, R⁵ and R⁶) of the general formula II to arrive at the present invention. The Examiner notes that Brown et al. teach the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the

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invention would be *prima facie* obvious to one of ordinary skill in the art. Therefore, the instantly claimed invention would have been suggested to one of ordinary skill in the art.

No claims (1-14) are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.
Patent Examiner
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A handwritten signature in black ink, appearing to read "Johann R. Richter", with the letters "FOR" written below it.

Johann R. Richter, Ph.D., Esq.

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Supervisory Patent Examiner,
Technology Center 1600